

REMARKS

Claims 1-10 are pending and rejected in this application. Claims 1, 5 and 10 are amended hereby.

Responsive to the objection to the drawings, the Applicant has amended Figure 2. Replacement Fig. 1-2, replaces the original sheet including Fig.1-2. In Fig. 2 the previously omitted element 40 has been added.

Applicant hereby submits that the attached drawings are now in condition for allowance. Additionally formal drawings will be submitted upon allowance.

Responsive to the rejection of claims 1, 5, and 10 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention, the Applicant has amended claims 1, 5, and 10 keeping in mind the Examiner's comments, for which courtesy the Examiner is thanked.

More particularly, claims 1 and 5 have been amended to correct an antecedent error identified by the examiner. Claims 1 and 5 have been amended changing the phrase "the entire side perimeter" to "an entire side perimeter". Additionally, claims 1 and 5 have been amended changing the phrase " the corresponding outer surface" to "a corresponding outer surface". Furthermore, claim 1 has been amended to clarify the phrase, "two opposing walls". The phrase now reads "two opposing sides of the outer wall". Finally, claim 10 has been amended to depend from claim 5.

Applicant hereby submits that amended claims 1-10 are now in condition for allowance, which is hereby respectfully requested.

Responsive to the rejection of claims 1 and 5-7 under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 3,350,946 (Isreeli), Applicant respectfully traverses.

Isreeli discloses a "vial 12 having a boss 14 mounted to the exterior surface by a suitable adhesive. The boss 14 has a card-like member 16 mounted thereto by suitable means, such as adhesive, or...by rivet-like projections 18 passing through respective holes 20 in the member 16." (*Column 2, lines 16-21*). (*Fig. 1*). Additionally, Isreeli discloses, a "marginal portion 32 of the card-like member extends laterally beyond the boss 14 and has a plurality of notches 34 formed therein. The arrangement of notches and absences thereof, or lands, forms a combinational code, uniquely identifying the sample receptacle". (*Column 2, lines 30-35*). (*Fig. 1*).

In contrast, claim 1 recites in part, an "identification tag having a one-piece rigid substrate body having an outer wall of varying height around an entire side perimeter of said tag, raised indicia for identifying said pipe located on an upper flat surface". (*Emphasis added*).

Furthermore, claim 5 recites in part, " an identification tag having a one-piece rigid substrate body having an outer wall of varying height around an entire side perimeter of said tag, said outer wall comprising a first pair of opposing sides and a second pair of opposing sides, said identification tag having indicia for identifying said pipe located on an upper flat surface". (*Emphasis added*).

Applicant submits that the novel structure of the present invention is not disclosed in Isreeli. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631,

2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, the identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner relies on Isreeli to identify all of the limitations of the Applicant's claims 1 and 5. However, Isreeli fails to disclose a "one-piece rigid substrate body". In Isreeli, the device is two pieces, a card like member 16, mounted to a boss 14. The Applicant's invention has significant advantages over Isreeli. The one-piece rigid substrate body of the Applicant's invention eliminates the time and expense associated with mounting or riveting the card like member of Isreeli to the boss 14 or vial 12. Therefore, since Isreeli fails to disclose all of the limitations of the Applicant's Claims 1 and 5, it does not anticipate Claims 1 and 5.

Additionally, Isreeli does not disclose indicia for identifying said pipe located on an upper flat surface. Isreeli discloses a marginal or side portion 32 of the card-like member extending laterally beyond the boss 14 and having a plurality of notches 34 formed therein. Applicants claims 1 and 5 recite a "side perimeter" and an "upper flat surface." The notches in Isreeli are formed in the side portion, not the upper flat surface as claimed in the Applicant's invention. Furthermore, claim 1 recites in part, "raised indicia for identifying said pipe located on an upper flat surface". (*Emphasis added*). The plurality of notches disclosed in Isreeli are recessed rather than raised. Therefore, since Isreeli fails to disclose all of the limitations of the Applicant's Claims 1 and 5, it does not anticipate Claims 1 and 5.

Finally, claims 1 and 5 recite in part, " an outer wall of varying height around the entire side perimeter of said tag".

Isreeli discloses a card-like member wherein, "one marginal portion 32 of the card-like member extends laterally beyond the boss 14". (*Column 2, lines 29-31*). (*Figs. 1 and 4*). Isreeli does not disclose the outer wall of varying height around the entire side perimeter of said tag, conversely, the outer wall of Isreeli can not be around the entire side perimeter of the tag, because the tag or card like member 16 extends beyond the sidewall or boss 14. (*Column 2, lines 29-31*). (*Figs. 1 and 4*).

For the foregoing reasons, Applicant respectfully submits that claims 1 and 5 are in condition for allowance, which is hereby respectfully requested.

Responsive to the rejection to claim 7, Applicant submits that claim 7 is in condition for allowance because it depends from claim 5, which is in condition for allowance for the reasons given above.

For the reasons above, Applicant hereby submits that claims 1, 5, and 7 are in condition for allowance, which is hereby respectfully requested.

Responsive to the rejection of Claims 3 and 4 under 35 U.S.C. §103(a), as being unpatentable over U.S. 2002/0032102 (Boire, et al.) in view of U.S. Patent No. 3,350,946 (Isreeli), Applicant respectfully traverses.

Isreeli discloses a card-like member wherein, "one marginal portion 32 of the card-like member extends laterally beyond the boss 14". (*Column 2, lines 29-31*).

Claims 1 and 5 recite in part, "an outer wall of varying height around the entire side perimeter of said tag".

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the

patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Examiner relies on Isreeli for the outer wall of varying height around the entire side perimeter of said tag, however the outer wall of Isreeli is not around the entire side perimeter of the tag. The tag or card like member 16 extends beyond the sidewall or boss 14. (*Column 2, lines 29-31*). (*Figs. 1 and 4*).

Since all of the claim limitations are not taught in the prior art presented by the examiner, a prima facie case of obviousness has not been established.

For the foregoing reasons, Applicant respectfully submits that independent claims 1 and 5 are in condition for allowance which is hereby respectfully requested.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998).

For the forgoing reasons, Applicant respectfully submits that dependant claims 2, and 6-8 are in condition for allowance, which is hereby respectfully requested.

Responsive to the rejection of claims 3, 4, 9 and 10 under 35 U.S.C. §103(a), as being unpatentable over U.S. 2002/0032102 (Boire et al.) in view of U.S. Patent No. 3,350,946 (Isreeli), as applied to claims 1 and 5, and in further view of applicant's admitted prior art, Applicant respectfully submits that claims 3, 4, 9 and 10 are in condition for allowance because they depend from claims 1 and 5 which are in condition for allowance for the above stated reasons.

Responsive to the rejection of claims 2 and 8 under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 3,350,946 (Isreeli) in view of U.S. Patent 4,196,424 (Williamson), Applicant respectfully submits that claims 2 and 8 are in condition for

allowance because they depend from claims 1 and 5 which are in condition for allowance for the above stated reasons.

Responsive to the rejection of claims 3, 4, 9 and 10 under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 3,350,946 (Isreeli) as applied to applicant's admitted prior art, Applicant respectfully submits that claims 3, 4, 9 and 10 are in condition for allowance because they depend from claims 1 and 5 which are in condition for allowance for the above stated reasons.


For the foregoing reasons Applicant respectfully submits that claims 1-10 are in condition for allowance which is hereby respectfully requested.

In the event Applicant has overlooked the payment of fee, or additional payment of fee, Applicant hereby conditionally petitions therefore and authorizes that any charges be made to Deposit Account No. 10-0223, JAECKLE FLEISCHMANN & MUGEL, LLP.

Should you have any questions regarding the enclosed, please do not hesitate to contact me.

Respectfully submitted,

Date: September 18, 2003


Frank V. Gallucci
Reg. No. 51,211

JAECKLE FLEISCHMANN & MUGEL, LLP
39 State Street, Suite 200
Rochester, New York 14614-1310
Telephone: (585) 262-3640
Facsimile: (585) 262-4133